

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WILLIAM P. APPS

Appeal No. 2005-1403
Application No. 09/780,073

ON BRIEF

Before McQUADE, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

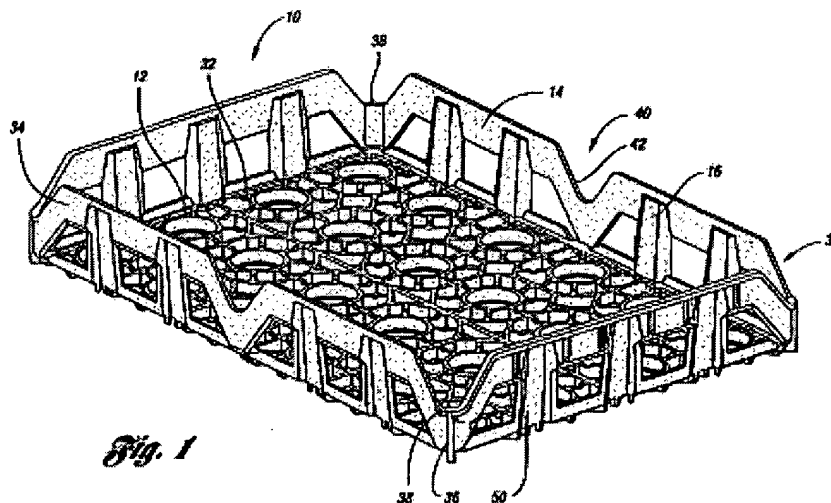
This is a decision on appeal from the examiner's final rejection of claims 1 to 28, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claim 22 was amended after the final rejection resulting in the withdrawal of the rejection of claims 22-28 under 35 U.S.C. § 112, second paragraph.

BACKGROUND

The appellant's invention relates to a low depth, nestable tray for transporting and storing beverage containers having substantially equal diameters, such as twelve-ounce aluminum beverage cans (specification, p. 1). Figure 1, reproduced below, is a top perspective view of a tray in accordance with the appellant's invention.



A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The references of record relied upon by the examiner in rejecting the appealed claims are:

Carroll	Des. 239,213	Mar. 16, 1976
David	4,079,077	Mar. 14, 1978
Apps (Apps '925)	5,323,925	June 28, 1994
Apps (Apps '204)	Des. 404,204	Jan. 19, 1999
Apps (Apps '328)	6,186,328	Feb. 13, 2001

The following grounds of rejection are before us in this appeal:

1. Claims 1-28 under the judicially created doctrine of double patenting over claims 1-13 of Apps '328 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.
2. Claims 1-28 under the judicially created doctrine of double patenting over drawing figures 1-10 of Apps '204 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.
3. Claims 13-18 and 21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.
4. Claims 6, 8, 9 and 12 under 35 U.S.C. § 102(b) as being anticipated by Carroll.
5. Claims 6-18 and 21-26 under 35 U.S.C. § 102(b) as being anticipated by Apps '925.

6. Claims 1-10, 12-15, 17-19 and 21-28 under 35 U.S.C. § 103 as being unpatentable over Carroll.
7. Claim 8 under 35 U.S.C. § 103 as being unpatentable over Apps '925 in view of David.
8. Claims 11, 16 and 20 under 35 U.S.C. § 103 as being unpatentable over Carroll in view of Apps '925.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (mailed April 2, 2003) and the answer (mailed April 21, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed September 25, 2003) and reply brief (filed June 22, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The double patenting rejections

The examiner has set forth the bases for these rejections in the following manner (final rejection, pp. 6-7):

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A tray for supporting cans comprising a floor structure and a low depth wall structure, the wall structure having a plurality of columns and a band member with side and end portions.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

"Obviousness-type" double patenting is a judicially established doctrine which prevents an unjustified extension of the patent right beyond the statutory time period, that is, it extends the fundamental legal doctrine of double patenting to include "obvious variants" of what already has been patented. See, for example, In re Berg, 140 F.2d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998) and General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279-80, 23 USPQ2d 1839, 1845 (Fed. Cir. 1992). A rejection on the basis of obviousness-type double patenting thus must establish that the claims of the application would extend the rights granted to the patentee.

With regard to rejections under the doctrine of obviousness-type double patenting, the examiner is instructed by Section 804 of the Manual of Patent Examining Procedure (MPEP) as follows (emphasis added):

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. § 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined in the conflicting claims – a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

The examiner therefore is required to establish that **each** application claim being rejected under the theory of obviousness-type double patenting is not patentably distinct from a claim in the applied patent or patent application in the case of a provisional rejection.

However, the examiner has not acted in accordance with this guidance in the present case. In the statement of the rejection the examiner has merely grouped together a number of claims in the application, pointed out some common features in the application claims that are present in the claims of the applied patents or patent application, and then declared that the application claims were unpatentable. It is our view that the examiner therefore has failed to establish a prima facie case of obviousness-type double patenting with regard to claims 1 to 28.

Additionally, the examiner failed to apply a "two-way" test between the design patent and the claims under appeal. The Federal Circuit stated in In re Dembiczak, 175 F.3d 994, 1002, 50 USPQ2d 1614, 1619 (Fed. Cir. 1999) that:

The law provides that, in some very rare cases, obvious-type double patenting may be found between design and utility patents. *See Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 939-40, 220 USPQ 481, 487 (Fed. Cir. 1983) (noting that, while theoretically possible, "[d]ouble patenting is rare in the context of utility versus design patents"); In re Thorington, 418 F.2d 528, 536-37, 163 USPQ 644, 650 (CCPA 1969) (Double patenting between a design and utility patent is possible "if the features producing the novel aesthetic effect of a design

patent or application are the same as those recited in the claims of a utility patent or application as producing a novel structure."); *In re Phelan*, 205 F.2d 183, 98 USPQ 156 (CCPA 1953); *In re Barber*, 81 F.2d 231, 28 USPQ 187 (CCPA 1936); *In re Hargraves*, 53 F.2d 900, 11 USPQ 240 (CCPA 1931). In these cases, a "two-way" test is applicable. See *Carman*, 724 F.2d at 940, 220 USPQ at 487. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that "the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa." *Id.*, 220 USPQ at 487. See also *Braat*, 937 F.2d at 593, 19 USPQ2d at 1292 (explaining two-way test).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 28 under the judicially created doctrine of double patenting over claims 1-13 of Apps '328 is reversed and the decision of the examiner to reject claims 1-28 under the judicially created doctrine of double patenting over drawing figures 1-10 of Apps '204 is reversed.

The indefiniteness rejection

We will not sustain the rejection of claims 13-18 and 21 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this

determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

With this as background, the specific basis for the rejection under 35 U.S.C.

§ 112, second paragraph, is as follows (final rejection, p. 2):

Claim 13 recites the limitation "the upper edge" of the band side detail in the second to last line. There is insufficient antecedent basis for this limitation in the claim because it can't be determined if "the upper edge" refers to the "uppermost edge" previously recited in the claim. The claim is ambiguous since the upper edge could refer to any upper edge and upper edge which is not an uppermost edge or an uppermost edge.

In our view, antecedent basis for "the upper edge" is sufficiently provided by "an uppermost edge." As such, claims 13-18 and 21 do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity as required by the second paragraph of 35 U.S.C. § 112.

For the reasons set forth above, the decision of the examiner to reject claims 13-18 and 21 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation rejection based on Carroll

We will not sustain the rejection of claims 6, 8, 9 and 12 under 35 U.S.C. § 102(b) as being anticipated by Carroll.

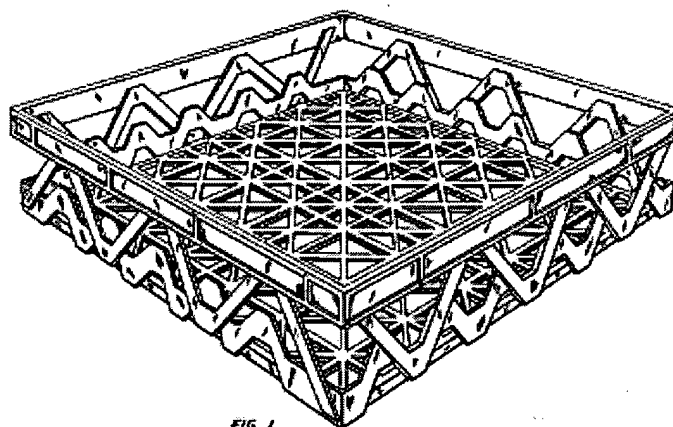
A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 6, the only independent claim subject to this ground of rejection, reads as follows:

A low depth nestable tray of [sic, for] containers, said tray having a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface, wherein the improvements comprise:

a low depth wall structure comprising a plurality of columns arranged generally perpendicularly to the floor structure along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure and connected to the floor structure by said columns to form a unitary construction, wherein said band includes parallel portions generally parallel to the floor structure and is contoured downwardly along the side portions between the parallel portions to form a band central portion that directly connects to the floor structure at the side portions of said tray.

Carroll's invention relates to a bakery tray or the like. Figure 1, reproduced below, is a top perspective view of the bakery tray.



The specific basis for this anticipation rejection is as follows (final rejection, pp.

2-3):

Carroll discloses a low depth nestable tray which is inherently capable of holding containers, the tray comprises a floor structure with container support areas and a low depth wall structure comprising columns (portions of the outer zig-zag bands which attach the inner zig-zag band to the floor structure) and a band (the annular inner zig-zag band), the band has side and end portions spaced above the floor structure and connected to the floor structure by the columns, the band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of the tray.

Thus, in this anticipation rejection, the examiner has determined that the claimed columns were readable on portions of the outer zig-zag bands and the claimed band was readable on the inner zig-zag band. Claim 6 recites that the band is connected to the floor structure by the columns. While the examiner stated that Carroll's band (the inner zig-zag band) is connected to the floor structure by the columns (the outer zig-zag bands), the examiner has not explained how this is so. As shown in Figure 1 of Carroll, the inner zig-zag band of Carroll is connected directly to the floor structure and not by the outer zig-zag bands. We are uncertain how the examiner believes this claimed limitation is readable on Carroll. We decline to substitute speculation as to the rejection for the greater certainty which should have come from the examiner in a more definite explanation of the grounds of rejection. In that regard, the Manual of Patent Examining Procedure (MPEP) § 1208 (Eighth Edition, Rev. 2, May 2004) provides (p. 1200-19) that for a rejection under 35 U.S.C. § 102, the examiner's answer, or single prior action, shall explain why the rejected claims are anticipated, "pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." MPEP § 1208 also provides (p. 1200-19) that for a rejection under 35 U.S.C. 102 where there are questions as to how limitations in the claims correspond to features in the prior art, "the examiner shall compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page,

line number, drawing reference number, and quotation from the prior art, as appropriate."

For the reasons set forth above, the decision of the examiner to reject claim 6, and claims 8, 9 and 12 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

The anticipation rejection based on Apps '925

We will not sustain the rejection of claims 6-18 and 21-26 under 35 U.S.C. § 102(b) as being anticipated by Apps '925.

The invention of Apps '925 relates to low-depth, nestable trays for transporting beverage containers, such as aluminum cans. The tray 10, shown in the drawings, is integrally formed from a molded plastic material, such as polyethylene, and comprises principally a generally rectangular floor 12, a side structure 14 containing an enclosing rail 16 maintained in vertically spaced relation with respect to the floor by means of a plurality of columns 18 disposed in longitudinally spaced relation about the periphery of the apparatus. Support posts 20 located at each of the four corners of the tray serve to maintain the rail 16 in spaced relation to the floor 12 and provide additional corner support for the tray 10.

The specific basis for this anticipation rejection is as follows (final rejection, p. 3):

Apps discloses a low depth nestable tray for containers, said tray having a low depth wall structure comprising a plurality of columns (18) and a band (rail 16 and corner posts 20) having side and end portions spaced above the floor, the corner portion is formed by (posts 20) and wherein the band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of said tray.

Thus, in this anticipation rejection, the examiner has determined that the claimed columns were readable on columns 18 of Apps '925 and the claimed band was readable on the rail 16 and support posts 20 of Apps '925 taken together.

In our view, the claimed band is not readable on the rail 16 and support posts 20 of Apps '925 taken together since the structure of the rail 16 and support posts 20 of Apps '925 taken together is not a band. A band, as set forth on page 8 of the brief, is a thin strip of flexible material. Clearly, the rail 16 and support posts 20 of Apps '925 taken together do not constitute a thin strip of flexible material.

For the reasons set forth above, the decision of the examiner to reject claims 6-18 and 21-26 under 35 U.S.C. § 102(b) as being anticipated by Apps '925 is reversed.

The obviousness rejection based on Carroll

We will not sustain the rejection of claims 1-10, 12-15, 17-19 and 21-28 under 35 U.S.C. § 103 as being unpatentable over Carroll.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight

reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

The specific basis for this obviousness rejection is as follows (final rejection, pp. 4-5):

Carroll discloses the invention except for an uppermost edge of the corresponding band corner portion is not an uppermost surface of the wall structure at the corresponding band corner portion as stated in claims 1 and 22, the top edge of the band central portion is not the uppermost surface of the wall structure at the band central portion as stated in claim 7 and the uppermost edge of the band side detail is not the uppermost surface of the wall structure at the band side detail as stated in claim 13. See MPEP 2144.04 Part II, elimination of an element. It would have been obvious to remove an element with retention of the elements function. Therefore, it would have been obvious to remove the uppermost band which is parallel with the floor about its entire circumference and obvious to remove portions of the outer zig-zag band at the corner portions or any part of the outer zig-zag band which extends above a corresponding adjacent portion of the inner zig-zag band since the inner zig-zag band provides sufficient support to the sides of items stacked in the tray of Carroll and the elimination of the uppermost band and the portions of the outer zig-zag band

would save material cost of resin used in manufacturing and to save weight making transport of the trays more economical.

Clearly, absent the appellant's own disclosure, there is no motivation, suggestion or teaching in Carroll that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Carroll as set forth in this rejection. Accordingly, the decision of the examiner to reject claims 1-10, 12-15, 17-19 and 21-28 under 35 U.S.C. § 103 as being unpatentable over Carroll is reversed.

The obviousness rejection based on Apps '925 and David

We will not sustain the rejection of dependent claim 8 under 35 U.S.C. § 103 as being unpatentable over Apps '925 in view of David for the reasons set forth above with respect to parent claim 6. We have reviewed the reference to David applied in this rejection of claim 8 but find nothing therein which makes up for the deficiencies of Apps '925 discussed above with respect to parent claim 6. Accordingly, the decision of the examiner to reject claim 8 under 35 U.S.C. § 103 as being unpatentable over Apps '925 in view of David is reversed.

The obviousness rejection based on Carroll and Apps '925

We will not sustain the rejection of dependent claims 11, 16 and 20 under 35 U.S.C. § 103 as being unpatentable over Carroll in view of Apps '925 for the reasons set forth above in our treatment of parent claims 1, 6 and 13 based on Carroll alone. We have reviewed the reference to Apps '925 applied in this rejection but find nothing therein which makes up for the deficiencies of Carroll discussed above with respect to parent claims 1, 6 and 13. Accordingly, the decision of the examiner to reject claims 11, 16 and 20 under 35 U.S.C. § 103 as being unpatentable over Carroll in view of Apps '925 is reversed.

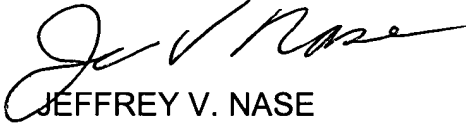
CONCLUSION


To summarize, the decision of the examiner to reject claims 1 to 28 under the judicially created doctrine of double patenting over claims 1-13 of Apps '328 is reversed; the decision of the examiner to reject claims 1-28 under the judicially created doctrine of double patenting over drawing figures 1-10 of Apps '204 is reversed; the decision of the examiner to reject claims 13-18 and 21 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 6, 8, 9 and 12 under 35 U.S.C. § 102(b) as being anticipated by Carroll is reversed; the decision of the examiner to reject claims 6-18 and 21-26 under 35 U.S.C. § 102(b) as being anticipated by Apps '925 is reversed; the decision of the examiner to reject claims 1-10, 12-15,

17-19 and 21-28 under 35 U.S.C. § 103 as being unpatentable over Carroll is reversed;
the decision of the examiner to reject claim 8 under 35 U.S.C. § 103 as being
unpatentable over Apps '925 in view of David is reversed; and the decision of the
examiner to reject claims 11, 16 and 20 under 35 U.S.C. § 103 as being unpatentable
over Carroll in view of Apps '925 is reversed.

REVERSED


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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